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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KLEBE, GERALD B

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/723,048	Applicant(s) JACOBS, ROBERT A.	
	Examiner Gerald B. Klebe	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 20 is/are rejected.
- 7) ☐ Claim(s) 18 and 19 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

YB Klebe
20 Oct 04

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/05/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections - Minor Informalities

1. The claims are objected-to for the following informalities:

Claim 12, in line 1: the word --is-- appears to be missing between “piece” and “located”;

Claim 17, in line 1: the word --the-- appears to be missing from between “wherein” and “ferrous”.

Appropriate correction is required.

Claims Rejections - 35 U.S.C. § 112, 2nd Paragraph

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 recites the limitation “said base plate” in line 2. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

Claims Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Crowther (US 2276826).

Crowther discloses (Figs 4-5) an attachment comprising: (re: claim 15)

A ferrous plate (22');

An attachment body (20) sized and configured to hold the ferrous plate (in the recess 37);

A rim (the edge of the recess (37) extending from the attachment body and located below the ferrous metal plate, the rim sized and configured to hold the ferrous metal plate within the attachment body (as shown); and

At least one strap (15) extending from the attachment body and sized to fit around the foot of a user (as shown); and

(re: claim 17) wherein the ferrous metal plate is recessed into the attachment body (as shown in Figs 4 and 5, the plate 22' fits within the recess 37 in the body 20).

EXAMINER'S NOTE: the recitation "... for a shoe used with a skateboard ..." represents intended use, and as such, is provided no patentable weight. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 U.S.C. §103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1- 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (JP 10-314365A), cited by Applicant with translation added by examiner, in view of Novali (GB 2163659A).

a. Yamamoto et al. discloses a sport gliding board comprising:

(re: claim 1)

A board deck;

A cavity located within the deck;

A ferrous pole piece sized and configured to fit within the deck cavity and having a magnet cavity located within the ferrous pole piece; and

A magnet located within the magnet cavity, and

Wherein the ferrous pole piece and magnet are connected with the board deck and located at least partially within the board deck cavity.

b. Yamamoto et al. discloses the invention relative to a snowboard instead of a skateboard.

However, Novali teaches the art equivalence of snowboards and skateboards and their features (refer to the specification, page 1, lines 73-76).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the features of Yamamoto et al. for use on a skateboard as an obvious design adaptation in accordance with the teachings of Novali.

c. Yamamoto et al. further discloses:

(re: claim 2)

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a base plate attached to the ferrous pole piece (taken as the flanges of the pole piece(s) as shown in Figure 4); and,

(re: claim 3)

Yamamoto et al. discloses that the ferrous pole piece (Fig 4, item 2) is attached with a screw (through screw holes 4, shown in Figure 4; refer to the specification translation provided by the examiner at page 11, paragraph [0034] in lines 2-5) instead of a rivet. However, the examiner takes Official Notice that in this application a screw is art equivalent to a rivet for attaching parts to each other and the selection of either of these known art equivalents would be within the level of ordinary skill in the art; and

(re: claim 4)

wherein the ferrous pole piece is cup-shaped (refer to the following examiner's note) and the magnet is located therein (refer Figs 1 and 4); and further comprising,

EXAMINER'S NOTE: The U-shaped form of the ferrous pole pieces is considered as being cup-shaped. Refer to Merriam-Webster's Collegiate Dictionary, Tenth Edition, 1998; definition of "cup".

(re: claim 6)

a second ferrous pole piece attached to a base plate (refer Fig 4 which shows an embodiment using a pair of ferrous pole pieces attached together and to a base plate, taken as the flanges with screw holes) and having a second magnet cavity located therein and a second magnet located within the second magnet cavity (as shown in Fig 4).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Yamamoto et al. (JP 10-314365A), cited by Applicant with translation added by examiner, and

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Novali (GB 2163659A) as applied to claim 1 above, and further in view of Aeschbach (US 5473963).

The combination of Yamamoto et al. and Novali lacks explicit disclosure of the magnets being neodymium-iron-boron (Nd-Fe-B). However, Aeschbach teaches a magnetic boot retainer that uses Nd-Fe-B magnets (col 3, lines 56-57). Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the disclosure of the combination of Yamamoto et al. and Novali to incorporate Nd-Fe-B magnets as a matter of obvious design choice based upon considerations of holding power, cost, and availability of these type magnets.

8. Claims 1 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Svetlov (US 5769438) in view of Yamamoto et al. (JP 10-314365A), cited by Applicant.

a. Svetlov discloses a skateboard for use with a shoe or shoe attachment, the skateboard comprising:

(re: claim 1)

a skateboard deck (Fig 2, item 1);

a deck cavity located within the deck; and a

a magnet (13) located within the deck cavity (refer col 2, lines 26-28); and

(re: claim 7) wherein the magnets are spaced apart such that a portion of the skateboard deck is located between the magnets; and ,

(re: claim 8) wherein a magnet is located proximate a front edge of the board deck; and

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(re: claim 9) further comprising a second magnet sized and configured to fit within a second deck cavity and wherein the second magnet is connected with the skateboard deck and located at least partially within the deck cavity; and,

(re: claim 10) wherein the first magnet is located proximate a front edge of the deck and the second magnet is located proximate a back edge of the deck; and,

(re: claim 12) wherein the second magnet is located on an upturned portion of the deck (taken as the top (20) portion of the deck; refer col 2, lines 26-27); and,

(re: claim 14) wherein the first magnet is located on a horizontal portion of the deck adjacent a first upturned portion, and wherein the second magnet is located on a second upturned portion of the deck.

b. Svetlov discloses magnets only rather than magnets located within magnet cavities located within ferrous pole pieces.

c. However Yamamoto et al. teaches the use of ferrous pole pieces having a magnet cavity within the ferrous pole piece and a magnet located within the magnet cavity, the ferrous pole piece-with-magnet-in-cavity-of-the-pole piece being used to provide a connection between a shoe and a sport board during use of the board.

d. Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have substituted the ferrous-pole-piece-with-magnet-in-a-cavity-of-the-pole-piece for the plurality of simple magnets embedded in the board by Svetlov in order to provide increased holding force between the board and the shoes of the user with fewer and less bulky magnetic devices as suggested by Yamamoto et al. (refer to the translation provided by the examiner in the specification at pages 4-5 paragraph [0008]).

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e. Regarding the limitations of claims 11, 13, and the further features of claim 14 wherein a magnet device is located with an edge between 0 and 10 inches from a back edge of the deck; and a magnetic device is located with an edge between 0 and 10 inches from a front edge of the deck, these are considered to be simple design choices obvious to one of ordinary skill in the art since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). See also MPEP § 2144.05 II. A.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crowther (US 2276826).

Crowther discloses the claimed invention except lacks explicit disclosure of the material of which the attachment body and the rim are made. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have used rubber as the material for the attachment body (and hence the rim) since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, and the use of rubber as a material of manufacture for the heels of sport boot is old and well-known. *In re Leshin*, 125 USPQ 416.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (JP 10-314365A), cited by Applicant with translation added by examiner, in view of Novali (GB 2163659A).

Yamamoto et al. discloses in combination :

A gliding board comprising :

A board deck (7),

A board deck cavity (not separately numbered; refer to the section cutout representing the cavity as shown in Fig 1) located within the deck,

A ferrous pole piece (2) sized and configured to fit within the board deck cavity and having a magnet cavity (not separately numbered, but clearly shown in section in Fig 1 as the cavity formed by the various walls of the pole piece (2)) located within the ferrous pole piece,

And a magnet (1) located within the magnet cavity,

Wherein the ferrous pole piece (2) and the magnet (1) are connected with the board deck and located at least partially within the board deck cavity (best understood from Fig 1; and refer to the translation paragraph [0023] at lines 1-3), and

A shoe attachment comprising:

A ferrous metal plate (3),

An attachment body (5), sized and configured to hold the ferrous metal plate (understood from the section view of Figure 1),

A rim (taken as the edges of the cavity in the attachment body (5) extending from the attachment body and located below the ferrous metal plate, the rim sized and configured to hold the ferrous metal plate within the attachment body (refer to the translation paragraph [0035] at lines 4-6), and

Wherein the magnet and ferrous pole piece provide sufficient attraction with the ferrous plate to keep the board proximate the shoe attachment during normal aerial maneuvers (refer translation page 13, paragraph [0041]).

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Yamamoto et al. discloses the invention relative to a snowboard instead of a skateboard and furthermore, Yamamoto et al. lacks explicit disclosure of the further limitation of at least one strap extending from the attachment body and sized to fit around the foot of a user.

However, Novali teaches the art equivalence of snowboards and skateboards and their features (refer to the specification, page 1, lines 73-76).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the features of Yamamoto et al. for use on a skateboard as an obvious design adaptation in accordance with the teachings of Novali.

Regarding the further feature of at least one strap extending from the attachment body and sized to fit around the foot of a user, the examiner takes Official Notice that it is old and well-known in the gliding board arts to use straps of various types as needed to bind the user's foot/feet to the board.

Allowable Subject Matter

11. Claims 18-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Prior Art made of Record

12. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art of Kulick (-552), of Kulick (-610), and of Sommer each show sport gliding boards having magnetic attachments devices for securing the shoes to the board; Phillips

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and Isman each show shoe attachment devices. These references show features in common with some of the other structures of the inventive concept disclosed in the instant application.

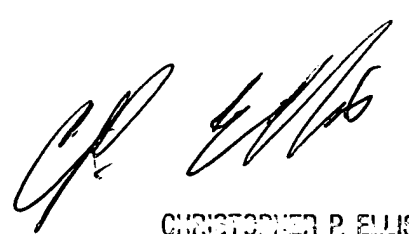
Conclusion

13. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 703-305-0578, fax 703-872-9306; Mon.-Fri., 8:00 AM - 4:30 PM ET, or to Supervisory Patent Examiner Christopher P. Ellis, Art Unit 3618, at 703-308-2560.

Official correspondence should be sent to the following TC 3600 Official Rightfax numbers as follows: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service: 703-872-9325.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


gbklebe / Art Unit 3618 / 20 October 2004


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SUPERVISORY PATENT EXAMINER
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